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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,458	08/13/2001	David Wallach	WALLACH=22A	6865

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08/19/2003

BROWDY AND NEIMARK, P.L.L.C.
624 Ninth Street, N.W.
Washington, DC 20001

EXAMINER

HUYNH, PHUONG N

ART UNIT	PAPER NUMBER
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1644

DATE MAILED: 08/19/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/927,458

Applicant(s)

WALLACH ET AL.

Examiner

Phuong Huynh

Art Unit

1644

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 July 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires Five months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.Claim(s) objected to: 14.Claim(s) rejected: 13, 15 and 16.Claim(s) withdrawn from consideration: 18-20 and 27-29.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 3. Applicant's reply has overcome the following rejection: The proposed amendment to claim 13 has overcome the rejection under 35 U.S.C. 112, first paragraph.

Continuation of 5. does NOT place the application in condition for allowance because: Claims 13, 15 and 16 stand rejected under 35 U.S.C. 102(e) as being anticipated by US Pat No 6,232,081 (May 2001, PTO 892).

The '081 patent teaches an isolated polypeptide which has the amino acid sequence such as LPLELKLRIFRLLDVRSVLSLSAVCRDLFTASNDPLLW, which is a fragment of the claimed polypeptide of SEQ ID NO: 2 encoding by a DNA clone under the accession number I-2706 (See SEQ ID NO: 47 of '081, column 2, lines 30-32, in particular). The functional properties of the reference fragment such as capable of inhibiting the NF-kB inducing effect of RIP or induction of NF-kB activity protects cell against TNF-mediated cell death is an inherent properties of the reference fragment because the claimed fragment of RIP appears to be the same as the reference fragment (See entire document, column 41, lines 44-45, in particular). The '081 patent teaches compositions comprising the reference protein and methods for development of drugs that disrupt at least one pathway in which the reference proteins function to ameliorate the effects of inflammatory response (See column 4, lines 37-50, in particular). Thus, the reference teachings anticipate the claimed invention.

Applicants' arguments filed 7/14/03 have been fully considered but are not found persuasive. Applicants' position is that (1) None of the claims of Harper are supported by the disclosure in the parent application. All of the claims of Harper are supported only by the new matter added to the 1998 application. Accordingly, the 35 USC 102(e) date for Harper is October 15, 1998. (2) The present claims are entitled to the effective filing date of March 19, 1998 as long as the claims are supported in the manner required by 35 USC 112, first paragraph, by the disclosure of the parent case, it does not matter if the parent case is a continuation-in-part or a continuation of a divisional.

However, claims 13, 15 and 16 are rejected under 35 USC 102(e) as being anticipated by US Pat No 6,232,081 using the contents, not the claims, of the issued patent which has supported in the specification of the parent (See page 95, SEQ ID NO: 47 of 08/951,621). If the reference SEQ ID NO: 47 was patented, SEQ ID NO: 47 is entitled to the filing date of the parent application under 35 USC 120, which is Oct 16, 1997.

As to the effective filing date of instant claims, the instant claim 13 is entitled to the effective filing date of 8/13/01 because the PCT/IL98/00125 filed 3/19/1998 does not have the support for "a RIP-associated protein (RAP) encoded by a DNA sequence in a clone deposited with Collection Nationale de Cultures de Microorganismes under accession number I-2706". In fact, the DNA sequence under accession number I-2706 has 2119 nucleotides while the DNA sequence encoding RAP in the PCT/IL98/00125 has 2154 nucleotides.

The instant claim 14 is entitled to the effective filing date of 8/13/01 because the PCT/IL98/00125 does not have the support for a polypeptide which is capable of binding to RIP which comprises a protein whose amino acid sequence is that of SEQ ID NO: 2. In fact, the polypeptide in PCT/IL98/00125 has 591 amino acids whereas the instant polypeptide of SEQ ID NO: 2 is 522 amino acids.

The instant claim 15 is entitled to the effective filing date of 8/13/01 because the PCT/IL98/00125 does not have the support for an isolated polypeptide which comprises the amino acid sequence of a fragment of a RIP-associated protein (RAP) encoded by a DNA sequence in a clone deposited with Collection Nationale de Cultures de Microorganismes under accession number I-2706.

The instant claim 16 is entitled to the effective filing date of 8/13/01 because the PCT/IL98/00125 does not have support for "A composition". Further, the polypeptide in the composition as set forth in claim 16 has no supported in the PCT/IL98/00125.



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